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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/613,841

07/03/2003

Dean A. Wacker

PH7112 DIV1

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03/15/2004

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EXAMINER

KUMAR, SHAILENDRA

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/613,841 | <b>Applicant(s)</b><br>WACKER ET AL. |  |
|                              | <b>Examiner</b><br>SHAIENDRA - KUMAR | <b>Art Unit</b><br>1621              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are non heterocyclic and G form urea or thio urea, classified in class 564, subclass 17+ and 32+.
  - II. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are non heterocyclic and G form carboxamide, classified in class 564, subclass 153.
  - III. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are non heterocyclic and G form ester, classified in class 560, subclass 8+.
  - IV. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are non heterocyclic and G form sulfonamide and thiosulfonamide, classified in class 564, subclass 64+.
  - V. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are non heterocyclic and G forms sulfoxy, classified in class 568, subclass 18+.
  - VI. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are non heterocyclic and G forms amidines, classified in class 564, subclass 225+.
  - VII. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are non heterocyclic and G forms cyano containing compounds, classified in class 558, subclass various.

- VIII. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are heterocyclic and G forms thiazolidine, classified in class 548, subclass various.
- IX. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are heterocyclic and G forms six membered heterocyclic ring containing more than one nitrogen in the ring, classified in class 546, subclass various.
- X. Claims 1-27, drawn to compounds, composition and method of use, when the compounds are heterocyclic and G forms six membered heterocyclic ring containing one nitrogen in the ring, classified in class 546, subclass various.
2. The inventions are distinct, each from the other because of the following reasons:
- The ten groups above are structurally divergent and classified separately according to U.S. Classification system. A reference anticipating one of the above groups may not render the others obvious under 35 USC 103. Hence restriction requirement is deemed proper.
3. In view of the complexity of the restriction requirement, a written restriction requirement is made.

Additionally, applicants need to elect a single disclosed species for either of the group elected for the examination purposes.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA - KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SHAILENDRA - KUMAR

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Primary Examiner  
Art Unit 1621

S.Kumar  
3/11/04